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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

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| EXAMINER |
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MULLIS, JEFFREY C

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| ART UNIT | PAPER NUMBER |
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1711

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,433

Applicant(s)

HAUBENNESTEL ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 1960.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1-8 and 12-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

See the previous Office action at page 3 lines 5 et seq.

It is not clear if claims 17-19 necessarily require at least two components for "A" given that many of the species recited embrace the "acrylate ester or methacrylate ester of a straight or branched alcohol having from 1 to 22 carbon atoms" such as methacrylates with a hydroxy function given that hydroxy functions are not excluded by "A" in claim 1 or the various other methacrylates recited by claim 17 and therefore a single component in some cases would meet the limitations of all components recited for "A".

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 12-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Legrand et al. (WO 9728200).

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See the previous Office action at the second complete paragraph on page 6 et seq.

Claims 1-8 and 12-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tetsuo (JP 63154769).

See the previous Office action at the paragraph bridging pages 6 and 7 et seq.

Claims 1-8 and 12-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horn et al. (USP 5,106,875).

Horn et al. disclose a composition containing a component "A" which has an olefinically unsaturated polyoxyalkylene alcohol adduct or polyester having "A" as in applicants' component "B". Note the Abstract as well as column 13 lines 31-34 and column 14 lines 8-11 in this regard. The copolymers also contain N-vinylimidazole. Note the Abstract in this regard which discloses patentees' component "B" (as in applicants' component "C"). The copolymer may also contain components "C" as well as "E" which both embrace applicants' component "A". Note the Abstract and that patentees' amounts of C and E together would be as high as 70 parts by weight within the metes and bounds of the claims.

No specific examples utilizing applicants' vinyl imidazole monomer in combination with applicants' other specific monomers are disclosed although Horn et al. discloses specifically that such may be used.

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It would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to utilize applicants' monomeric (including macromonomeric) components in applicants' amounts since Horn et al. specifically discloses that such may be done and in the expectation of adequate results absent any showing of surprising or unexpected results.

With regard to applicants' branched polymer molecular weight, use of applicants' molecular weight in the composition of Horn et al. would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in that it requires only routine experimentation to find the optimum or workable range of a result effective variable absent any showing of surprising or unexpected results.

Applicants' arguments filed 6-10-03 have been fully considered but they are not deemed to be persuasive.

With regard to MPEP § 2142, the Examiner acknowledges all the criteria discussed by applicants must be present in a proper rejection under 35 U.S.C. § 103. However the references relied upon both broadly disclose various embodiments embracing those of the instant claims and therefore any suggestion to arrive at applicants' combination of concentrations of monomers and specific monomers and/or macromonomers are suggested by the reference in that the reference discloses broadly that applicants' various materials may be used. Given the teachings

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of the reference, there is therefore reasonable expectation of success in forming compositions containing all of applicants' claim limitations.

With regard to Legrand, the instant claims do not exclude multiple sequences of reactions or use of telomers having reactive groups such as hydroxy groups.

Applicants argue that the copolymers disclosed in Legrand are different from the claimed polymers since the claimed polymers have macromers having reactive vinylic groups. However Legrand's examples specifically use macromers containing unsaturated end groups such as polyethylene glycol methacrylate. Note Legrand (WO 97/28200) in Example 1 on page 27 in this regard.

With regard to Tetsuo (JP 63154769), applicants argue that there is no teaching or suggestion to substitute the claimed acrylate and methacrylate esters for fatty acid modified monomers disclosed in Tetsuo. However, the Examiner does not agree that there need be such a suggestion since the monomers of Tetsuo read on applicants' monomers given that patentee's unsaturated monomers are made by the reaction of for instance hydroxyethyl acrylate with fatty acids. Since hydroxyethyl acrylate is embraced by applicants' "acrylate ester or methacrylate ester of a straight or branched alcohol having from 1 to 22 carbon atoms"

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and since applicants' claims recite "comprising", such a monomer reads on applicants' "A" component.

With regard to the rejection under 35 U.S.C. § 112, it is noted that the claims still contain the term "molecular weight" without qualification as to the type of molecular weight as it pertains to applicants' component "B".

With regard to Horn et al. '875, newly relied upon, this rejection has been made after applicants' citation of the reference and payment of a 1.17p fee and accordingly this Office action is made FINAL, MPEP § 609.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE

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ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc

September 24, 2003

Jeffrey Mullis
Primary Examiner
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